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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,882	01/30/2001	Chuan-Bao Wang	00250	2679
23338	7590	07/26/2005	EXAMINER	
DENNISON, SCHULTZ, DOUGHERTY & MACDONALD 1727 KING STREET SUITE 105 ALEXANDRIA, VA 22314			SINES, BRIAN J	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,882

Applicant(s)

WANG ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

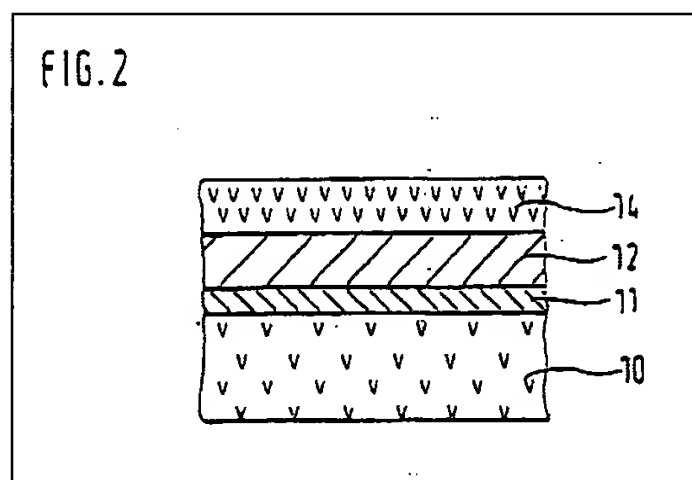
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 4, 6 – 14, 21 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (U.S. Pat. No. 4,246,228) in view of Friese et al. (U.S. Pat. No. 5,368,713 A).

Regarding claims 1, 12, 21 & 22, Jones et al. teach a combustible gas detection element comprising an electric heating element or filament (6) having a first coating layer, comprising a pellet with a precious metal oxidation catalyst supported on a porous oxide, such as zeolite; and a second coating layer overlaying the first coating layer, which acts as a molecular filter, wherein the second layer comprises a catalytic compound supported on a porous oxide comprising zeolite as well (see col. 1, line 1 – col. 2, line 28). Jones et al. do not specifically teach the incorporation of the coating layer structural configuration, which is adapted to function in the manner as recited by claim 1. Jones et al. do teach that around the pellet may be provided additional layers

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of catalytically active materials and/or an inactive non-catalytic porous material, the latter provided to act as a molecular filter (see col. 1, lines 45 – 51). However, Friese et al. teach a gas sensor comprising a porous ceramic coating comprised of at least two layers. The first layer (12) comprises a precious metal catalyst supported on a porous oxide; and a second layer (porous covering layer 14) overlaying the first layer, and comprising a catalytic compound, which is not substantially active towards combustible gases, but which provides sites reactive with and which are capable of trapping gases and vapors which poison the precious metal catalyst, wherein the catalytic compound being supported on a porous oxide (see figure 2). Friese et al. teach that the disclosed layer system has the advantage that the mixed oxides are able to trap the various contaminants usually occurring in exhaust gas, such as silicon, phosphorous, zinc or lead. The mixed oxide getters react with the contaminants from the exhaust gas to form reaction products. The high affinity of the alkali oxides for acidic oxides results in a beneficial gettering action with respect to silicon and phosphorous (see col. 1, lines 50 – 68). Friese et al. teach that, in addition to the mixed oxides, catalyst substances, in particular noble-metal catalysts, such as platinum, palladium, rhodium or others, can simultaneously be introduced into the porous covering layer (see col. 2, lines 4 – 23).



The cited prior art meet the three basic requirements to establish a *prima facie* case of obviousness (see MPEP § 2143). These three basic requirements are as follows: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The Courts have held that the teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (see MPEP § 2143.01). The Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (see MPEP § 2143.02). The Courts have held that to establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (see MPEP § 2143.03).

Regarding the first requirement, Friese et al. do teach the trapping of contaminant compounds, e.g., silicon compounds, which are then converted into stable compounds, which do not impair the operation of the sensor (see col. 1, lines 1 – 29). Furthermore, the mixed oxide getters, according to the Friese et al. disclosure, react with the contaminants from the exhaust gas to form reaction products having high melting points above the maximum application temperature of the layer system (see col. 1, lines 50 – 68). Friese et al. teach that the sensors comprising their disclosed coating layer system are largely insensitive to contaminants from

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exhaust gases (see col. 2, lines 52 – 59). Regarding the second requirement, as evidenced by the disclosure of Friese et al., a person of ordinary skill in the art would accordingly have had a reasonable expectation of success of incorporating the coating layer system of Friese et al., with the gas sensor of Jones et al., in order to provide a gas sensor with improved performance characteristics when exposed to contaminants from exhaust gases. Regarding the third requirement, as indicated above, the teachings of Jones et al. in view of Friese et al. teach and suggest all of the claimed structural limitations, which incorporate the functional aspects of the first and second layers of the coating layer system, of the gas sensing element as recited in claim 1. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the coating layer system, as disclosed by Friese et al., with the gas sensing element of Jones et al., in order to provide a gas sensor with improved performance characteristics when exposed to contaminants from exhaust gases. Regarding claim 2, Jones et al. teach the use of catalytic compounds, which may consist of metal-loaded zeolites, such as zeolite incorporating palladium or platinum (see col. 1, lines 38 – 56). Regarding claim 3, Jones et al. teach the use of alumina as a ceramic carrier material (see col. 1, lines 38 – 44). Regarding claim 4, Jones et al. teach that the heating element (6) comprises a helical filament heater (see col. 2, lines 11 – 28; figure 1). Regarding claim 6, Jones et al. teach that the catalytic compound of the second coating layer is in solid form (see col. 1, lines 45 – 51). Regarding claim 7, Jones et al. teach that the catalytic compound, such as platinum and palladium, is in powder form (see col. 1, line 66 – col. 2, line 3). Regarding claim 8, Jones et al. teach the incorporation of additional layers (see col. 1, lines 45 – 51). Regarding claim 9, Jones et al. teach that the second layer effectively acts as a molecular filter external to the pellet (see col. 1, lines 45 – 51). Regarding claim 10, Jones et al.

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teach that the external filter layer is formed from a homogeneous mixture resulting in a one-piece, monolithic structure (see col. 1, lines 45 – 51). Regarding claim 11, Jones et al. teach that the second coating layer may comprise multiple layers comprising a precious metal catalyst, such as platinum or palladium, supported on a porous oxide comprising zeolite (see col. 1, lines 38 – 56). Regarding claim 12, Jones et al. teach the further incorporation of a compensating element (see col. 2, lines 29 – 62). Regarding claim 13, as shown in figure 2, Jones et al. teach an electrical circuit to which the sensing element and the compensating element are connected (see col. 2, lines 29 – 62). Regarding claim 14, as shown in figure 2, Jones et al. teach a balanced or wheatstone bridge circuit.

The specification of how the apparatus is formed as recited in the newly amended portions of claims 1 & 12, and including new claims 21 & 22, is considered a product-by-process specification, in which the determination of patentability is based upon the apparatus structure itself. The patentability of a product or apparatus does not depend on its method of production or formation. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP § 2113).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

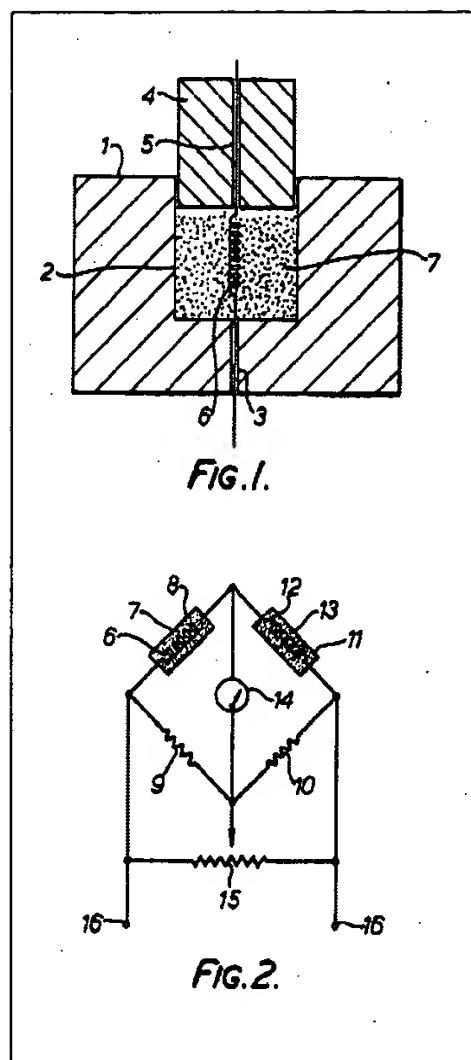
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. and Friese et al., and further in view of Cheng et al. (U.S. Pat. No. 5,670,115). Jones et al. teach that the heating element (6) comprises a helical filament heater (see figures 1 & 2, col. 2, lines 11 – 28). Jones et al. and Friese et al. are silent to the specific teaching of incorporating a heating element comprising an electric film heater. Cheng et al. do teach the incorporation of an electric film heater (52) with a gas sensor (30) (see col. 7, lines 51 – 62; figure 5).



As evidenced by Jones et al. and Cheng et al., both of these heating elements are considered functionally equivalent (see MPEP § 2144.06). The Courts have held that an express suggestion to substitute one equivalent component or process for another is not necessary to render such a substitution obvious. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Furthermore, the Courts have held that the change in form or shape is an obvious engineering design. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). Therefore, it would have been obvious to one of ordinary skill in the art to incorporate an electric film heater, as taught by Cheng et al., with the gas detector, as taught by Jones et al. in view of Friese et al., in order to provide more effective heating control to the sensor due to the difference in heat transfer properties afforded by the shape and surface area of the heater in the form of a film, rather than a helical wire configuration, depending upon the shape of the gas sensor.

Oath/Declaration

The declaration under 37 CFR 1.132, filed 5/24/2005, is acknowledged and has been reviewed by the examiner.

Response to Arguments

Applicant's arguments filed 5/10/2005 have been fully considered, but they are not persuasive. In response to applicant's argument that the combined teachings of Jones et al. and Friese et al. do not specifically teach *how to make* the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As pointed out by the applicant in the last paragraph on page 3 of the remarks, and as discussed above, Jones et al. and Friese et al. teach a desirable goal. The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage, or expected beneficial result would have been produced by their combination. See *In re Sernaker*, 702 F.2d 989, 994 – 995, 217 USPQ 1, 5, 6 (Fed. Cir. 1983) (see MPEP § 2144). The applicant is advised that the pending claims are drawn to an apparatus class of invention, not a process of making. There is sufficient disclosure in the cited prior art to render the claimed sensor apparatus structure conceptually obvious to a person of ordinary skill in the art. As discussed above, the cited prior art teach and/or suggest all of the positively recited structure of the claimed apparatus. The specification of how the apparatus is

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formed as recited in the newly amended portions of claims 1 & 12, and including new claims 21 & 22, is considered a product-by-process specification, in which the determination of patentability is based upon the final apparatus structure itself. The patentability of a product or apparatus does not depend on its method of production or formation. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP § 2113). It appears that the applicants invention may be more appropriately couched in terms of method claims, rather than apparatus claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

